

REMARKS

The applicant's remarks, below, are preceded by quotations of related comments of the examiner in small, boldfaced type.

Claims 32-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the 'progress of science and the useful arts' (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 32-34 only recite an abstract idea. The recited steps of merely storing information related to interactions with terminated employees, providing a prescribed interaction and storing the results does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to accumulate and store information related to a terminated employee.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is a 'computer based method'. Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the 'useful arts' when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for a patent eligibility is thus to determine whether the claimed invention produces a 'use, concrete and tangible result'...

In the present case, the claimed invention stores information related to interactions with a terminated employee and stores information related to available jobs that may be useful in placing the employee in a new job (i.e., repeatable), however, this information does not appear to be concrete since the result cannot be assured. There is no indication or limitation in the claim that would suggest the type of information that accumulated in order to make the stored results concrete. Also, this information is stored, however, does not appear to be provided to any individual or activity in order to realize some practical application of the invention and, therefore, appears to be an abstract idea. Thus, for these reasons, claims 32-34 are deemed to be directed to non-statutory subject matter.

Without conceding the examiner's position, the applicant has made amendments. The claims were and are within the technological arts. The preamble, which has now been positively recited in the claim, recites a useful, concrete, and tangible result.

Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parrish et al, U.S. Patent No. 5,416,694 in view of Feldman et al, "Managing Layoffs: Experiences at the Challenger Disaster Site and the Pittsburgh Steel Mills".

As per Claims 32-34, Parrish et al disclose storing information about the qualifications of an employee planning an occupational readjustment (Figure 1; Col. 3, lines 40-45; Col. 5, lines 50-63); providing a prescribed interaction such as an interview to accumulate information useful in placing the employee in a new job (Col. 3, line 55-Col. 4 line 5) and assembling and storing this information (col. 5, lines 50-63), storing information about available jobs (Col. 3 line 65-Col 4 line 5; Col. 5, lines 17-25) and matching the stored information (Col. 1, lines 60-68; Col. 2, lines 20-25 and 47-52).

Parrish et al, however, fail to explicitly disclose that the method is used for employees that have been non-voluntarily terminated. Feldman et al disclose that terminated employees should be provided with outplacement assistance such as career counseling sessions and direct placement assistance to help employees locate job opportunities (Pages 4-5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Parrish et al and include this type of job placement service for employees that have been terminated. Parrish et al indicates that the invention is used for occupational readjustments suggesting that it may be used for employees that have lost a job or are looking for a job for various reasons. Feldman et al also provides motivation by indicating that providing outplacement services would help minimize the negative effects of layoffs on both the employees and the organization (Page 1-2).

The applicant disagrees. All of the claims 32 through 34 provide for "reducing a durational risk associated with benefits to be paid under an insurance product." Neither Parrish, who is focused on "determining occupational transition paths" (col. 1, lines 63-64), nor Feldman, who aims to "facilitate the efforts of laid-off workers to find satisfactory new employment (page 56)," describes or suggests a system that reduces durational risk associated with benefits to be paid under an insurance product. Claims 32 through 34 are patentable for at least that reason.

In addition, neither Parish nor Feldman discloses or suggests the use of a prescribed interaction with terminated employees. It is true that Parish mentions "a client desired position profile having a plurality of preselected parameters with a client assigned preferential weight associated with each parameter (col. 5, lines 50-53)" but that does not appear to be a prescribed interaction. Nor does Feldman supply the prescribed interaction that is missing in Parish, even though Feldman does mention "outplacement [that] encompasses a variety of assistance programs for laid-off workers, including résumé writing workshops, career counseling sessions, and direct placement assistance (page 58)." Because neither of the references discloses the providing of prescribed interactions, no combination of the references could have made the invention of claim 32 obvious to a person of ordinary skill in the field.

Dependent claim 34 is patentable for at least the same reasons as independent claim 32 on which it depends.

Claim 33 also recites the reduction of a durational risk and is patentable for at least that reason as explained with respect to claim 32. In addition, claim 33 is patentable because neither Parrish (which discusses "identifying a match between a participant's skills and interests ... with those of a particular demand occupation" (col. 1, lines 64-65)) nor Feldman (which describes centers that "gave the laid-off employees access to bulletin boards with job listings, desks with telephones, and secretarial services" (page 58)) discloses or suggests doing the "matching" of qualifications and available jobs on the computer stored information.

The fact that the applicant has responded to certain positions taken by the examiner does not mean that the applicant concedes any other positions of the examiner. The fact that the applicant has stated certain reasons for patentability of the claims does not mean that there are not other good reasons for patentability of those claims or other claims.

The applicant asks the examiner to review the references cited in the Form 1449 filed on May 6, 2002, and check them off.

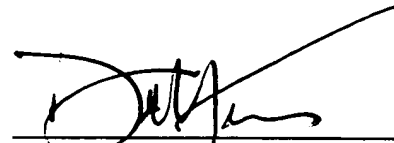
Applicant : Brock W. Callen et al.
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Attorney's Docket No.: 10180-002003

Enclosed is a check for \$475 for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, reference 10180-002003.

Respectfully submitted,

Date: 10/3/3



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